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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:

William Paul Schmidt

Serial No.: 10/621,131

Group Art Unit: 2872

Filed: July 16, 2003

Examiner: Mark A. Robinson

For: REMOTE CONTROLLED CROSSOVER MIRROR

Attorney Docket No.: ML 0166 PUS

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REPLY BRIEF TO EXAMINER'S ANSWER

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
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Dear Sir:

The following Reply Brief is submitted in response to the Examiner's Answer, mailed November 28, 2006 and allowing two months for response. Applicant herein submits this Reply Brief to address the Examiner's Response to Arguments Section

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to correct any inaccuracies or misconceptions created by the Examiner in the record so that the Board has a clear understanding of the Applicant's positions.

I. Supplemental Argument

In Section 10 (Response to Arguments), beginning on page 4 of the Examiner's Answer the Examiner mischaracterizes or misinterprets the Applicant's arguments that the Examiner has failed to establish a *prima facie* case of obviousness as required by Section 2143 of the Manual of Patent Examining Procedure. The Applicant will herein address each of the Examiner's mischaracterizations so that the issues are properly presented to the Board for consideration.

Referring first to Page 5, first full paragraph, the Examiner states that:

"This argument appears to contradict appellant's statement on page 7 of the brief, where it acknowledges that the reference, when combined, teach all of the claimed elements."

This statement is inaccurate because it places the Applicants statement in a different context in which it was argued. Applicants have consistently maintained that the combination of Englander, Foster and Bateman do not teach all the claim limitations of claims 1 and 3-5. (emphasis added). What the Applicants were attempting to point out on page 7 of its Appeal Brief is that, even if the Board does not agree with the Applicant that all the elements are not taught by the combination of Englander, Foster and Bateman, this establishes only one of the three necessary criteria required for establishing a *prima facie* case of obviousness according the MPEP 2143. The Examiner still has not established with the first or second criteria for establishing a *prima facie* case of obviousness according the MPEP 2143, namely that there is a suggestion or motivation to combine and further that there is a reasonable expectation of success, which the Applicants discussed beginning on page 10 of its Corrected Brief on Appeal.

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With respect to the third criteria for establishing a *prima facie* case of obviousness according the MPEP 2143, the Applicants have consistently maintained that combination of Englander, Foster and Bateman do not teach a crossover mirror assembly having a tubular region, wherein the tubular region discloses a center point. The Examiner's presents arguments in his Answer that Bateman and Foster teach specific elements or structures (for example, the actuator and controller assemblies, the tubular assemblies etc.) that, when combined with Englander, teach all of the elements of the Applicants proposed claims. However, Foster and Bateman are directed to rearview mirrors, not crossview mirrors. The Applicants have consistently maintained that it is improper to combine elements purportedly found in a rearview mirror to additional elements found in a crossview mirror to arrive at the presently claimed invention. Moreover, from what is illustrated in the figures and in the description of Englander, Applicants argued that it is unclear as to whether the mirror illustrated is a crossview mirror having a tubular region, wherein the tubular region discloses a center point – it is simply not shown in sufficient detail or described in any particularity in the specification. Applicants statements in the first full paragraph of page 6 of the Answer that Englander "probably" includes a tubular region is insufficient and inapposite of what is required by MPEP 2143 – namely a specific teaching of each and every element – not a supposition that an element is "probably" there. Thus, the Examiner has provided no proof of each and every element of claims 1-3, 6 and 7 of the present invention. As such, the Examiner has not established the third criteria for establishing a *prima facie* case of obviousness according the MPEP 2143, and thus the Examiner's rejection must be overturned.

Moreover, the Examiner has provided no appropriate reasons why one would wish to add the purported structures found in either Bateman or Foster to Englander to purportedly arrive at what is claimed in claims 1-3, 6 and 7 of the present invention, and hence establish the first criteria for establishing a *prima facie* case of obviousness according the MPEP 2143. Englander is directed to a method for testing mirrors for regulatory compliance. The method qualifies and certifies the field of view coverage of mirror systems with predetermined criteria. (Emphasis Added) As stated in column 1, lines 28-43, the certification process involves mounting a

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prototype mirror on a bus, placing cylinders of a specified size alongside the front of the bus at precisely prescribed distances from the bus in a prescribed arrangement, and determining whether the mirrors are capable of reflecting an image of a certain size. If this image is of a certain size, the mirrors are compliant. If not, the mirrors must be redesigned. The Englander reference teaches a software package that uses artificial visualization to determine compliance, it has nothing to do with the structure of the crossview mirror itself. Further, there is no teaching or suggestion in Englander to adjusting the prototype mirror during the certification process, as it is assumed that the prototype mirror is positioned properly and thus there is no need for any subsequent adjustments or structures in the form of electronic actuators and electronic controllers for controlling the relative positioning of the arcuate mirror. Thus, contrary to the Examiner's statements on Page 8 of his Answer, there is simply no reason to solve a "problem" that is not present, moreover there is no "vehicle driver" that needs to get out of the bus to adjust the mirror – Englander uses a computer program that inputs the relevant criteria from the prototype mirror properly positioned to determine an artificial visualization in a mirror, and hence the compliance of the mirror. Thus, contrary to the Examiner's suggestion, there is no motivation or suggestion to combine Foster, Bateman and Englander to arrive at the present invention. Thus, the Examiner has failed to establish the first criteria for a *prima facie* case of obviousness according the MPEP 2143

Finally, the Examiner has provided no reasons to suggest that combining the structures of Foster, Bateman and Englander would form a crossview mirror assembly as in claims 1-3, 6 and 7. As stated above, Englander is a method for certifying prototype crossview mirrors, the structure of the prototype mirror itself will vary from test to test. Further, as stated in the Appeal Brief, there is no explanation or showing in Englander as to whether the prototype mirror has a tubular region, wherein the tubular region discloses a center point, and whether the mirror itself can be rotated, much less rotated to a predetermined angle is not greater than approximately 45 degrees counterclockwise or clockwise from said centered position. As the structure in Englander is not known with any specificity, it is impossible to determine whether or not additional structures, or what structures,

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from Bateman or Foster could be added to Englander to arrive at the present invention as disclosed in claims 1-3, 6 and 7.

Thus, the Applicants believe that the Examiner has failed to establish any of the three criteria, much less each of the three criteria, for establishing a *prima facie* case of obviousness according the MPEP 2143, and thus the Examiner's rejection of claims 1-3, 6 and 7 must be overturned.

II. Conclusion

For the foregoing reasons, Applicant respectfully requests that the Board direct the Examiner in charge of this examination to withdraw the rejections and pass claims 1-3, 6 and 7 to issuance.

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Dated: January 23, 2007